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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/477,270	01/04/2000	Steven M. Menchen	9584-008-999	8958
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22896 7590 03/07/2003

MILA KASAN, PATENT DEPT.  
APPLIED BIOSYSTEMS  
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FOSTER CITY, CA 94404

EXAMINER

SAEED, KAMAL A

ART UNIT	PAPER NUMBER
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1626

12

DATE MAILED: 03/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/477,270

Applicant(s)

MENCHEN ET AL.

Examiner

Kamal A Saeed

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 18-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

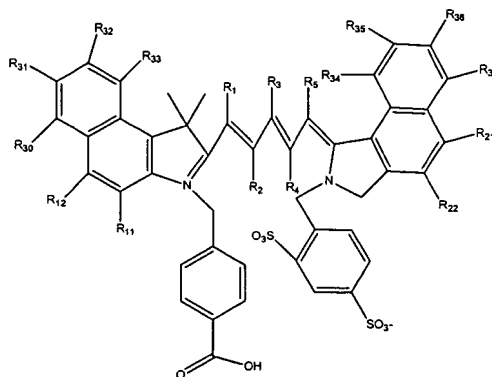
Claims 1-41 are pending in this application.

The restriction requirement of Paper No. 9, have been modified to include an additional  
Invention of Group V as defined below:

- I. Claims 1-17, drawn to cyanine dyes classified in class 548 and subclass 467+
- II. Claims 18-25, 28 and 34, drawn to labeled nucleoside and nucleotide derivatives, classified in class 536, subclass 32+
- III. Claims 26, 27 and 31-33, drawn to phosphoramidite reagents, classified in class 558, subclass 166+
- IV. Claims 35-37, drawn to methods for generating a labeled primer extension product, classified in class 435, subclass 91.1.
- V. Claims 38-41, drawn to a kit for generating a labeled primer extension product classified in class 206 and several subclasses.

***Response to Restriction***

During a telephone conversation with Vincent M. Powers, on March 3, 2003, an election was made with traverse the Invention of Group I, claims 1-17, drawn to cyanine dyes and the



species of , compound of Formula I.I,

, recited last in

page 59 of the specification.

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The traversal is on the ground(s) that each of the elected Group could be extended to other groups without imposing an undue burden on the Examiner. This is not found persuasive because each of the various Groups is directed to art recognized compounds which are different from each other and, are capable of supporting their own patents. Moreover, the examiner is required to conduct a commercial data base search on the class and each subclass. This would be an undue burden on the examiner.

Therefore, the restriction requirement in paper No. 6 is still deemed proper and is made FINAL.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants preserve their right to file a divisional on the non-elected subject matter.

#### ***Status of the Claims***

Claims 1-41 are pending in this application. Claims 18-41 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference which anticipates one group would not render obvious the other.

The generic concept of the elected subject matter is follows:

Compound of Formula *II*, of claim 17, wherein

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$R^1, R^2, R^3, R^4, R^5, R^6$  and  $R^7$  are each independently selected from the group consisting of hydrogen, halogen, CN,  $CF_3$ ,  $(C_1-C_6)alkyl$ ;

$R^{11}, R^{12}, R^{13}, R^{14}, R^{15}, R^{16}, R^{17}, R^{18}, R^{19}, R^{20}, R^{21}, R^{22}, R^{23}, R^{24}, R^{25}, R^{26}, R^{27}, R^{28}, R^{29}, R^{30}, R^{31}, R^{32}, R^{33}, R^{34}, R^{35}, R^{36}$  and  $R^{37}$  are as defined;

$k, l$  and  $m$  are each independently integers from 0 to 1;

$o$  and  $q$  are an integer from 1 to 3

$p$  is an integer from 0 to 2.

As a result of the election and the corresponding generic concept identified, the remaining subject matter of claims 1-17 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn subject matter of claims 65 and 66 is properly restricted as it differs materially in structure and in element from the elected subject matter supra so as to be patentably distinct there from.

### ***Objections***

Claims 1-17 are objected to for containing non-elected subject matter. Claims drawn solely to the elected invention as identified supra, would appear allowable. The claims must be amended to exclude non-elected subject matter and within the limit of elected compounds of formula *II*.

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal Saeed whose telephone number is (703) 308-4592. The examiner can normally be reached on Monday-Friday from 8:00 AM – 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308 4537. The unofficial fax phone for this group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate the Header (upper right) "Official" for papers that are to be entered into the file, and " Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-2286.

Kamal Saeed, Ph.D.  
March 04, 2003

  
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Joseph K. McKane  
Supervisory Patent Examiner  
AU 1626